

REMARKS/ARGUMENTS

Responsive to the Office Action dated October 2, 2006, Applicant appreciates the Examiner's withdrawal of the previous claims rejections under 35 U.S.C. § 112 and § 102. In this Amendment, Claim 4 has been amended. Claims 1-5 and 7 therefore remain pending for prosecution with Claim 1 being independent.

I. Claim Rejections under 35 U.S.C. § 112

Claim 4 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and claim the subject matter which applicant regards as the invention. In particular, it is asserted that it is not clear what comprises a "drawer pull mechanism." Applicant has therefore amended Claim 4 to recite a "pull mechanism" as that term is specifically defined and referenced (storage tray pull mechanism 50) throughout the specification. Applicant therefore respectfully requests withdrawal of this rejection.

II. Claim Rejections under 35 U.S.C. § 103

Claims 1-5 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,078,566 to Rackley in view of U.S. Patent No. 3,871,519 to Groomes. U.S. Patent No. 2,410,585 to Leitner is also cited. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. *MPEP* §2142. To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, to modify the references or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art must teach all the claim limitations. *MPEP* §2142. The teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the

prior art, and not based on applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant respectfully submits that a prima facie case of obviousness has not been established because both Rackley and Groomes, individually and in combination, fail to teach or suggest the claimed invention.

It is asserted that Rackley discloses a case 10 for carrying and storing circular saw comprising at least two trays 11, 12 provided with inserts 34, 36 that alter the inside diameter of the said at least two trays for limiting movement of a circular saw blade. Applicant respectfully traverses this assertion and submits that Rackley fails to teach or suggest the claimed invention. First, the case disclosed in Rackley consists only of a single tray not two trays as claimed by Applicant. The two halves of Rackley's case come together to form one cavity; therefore, the case only consists of one tray with two halves. Unlike the saw blades that are stored in the present invention, which consists of multiple trays that separate the blades individually, the blades stored in the case disclosed in Rackley are not separated and thus can become dull and damaged through contact with one another.

Second, the tubular bosses disclosed in Rackley do not act as annular inserts. Unlike the annular inserts in the present invention, Rackley's inserts do not alter the diameter of the storage tray in order to limit the movement of the saw blades. Further, they are not removable and therefore cannot be defined as inserts. Thus, Rackley fails to teach or suggest a generally circular case for carrying and storing circular saw blades including at least two storage trays, an annular insert within the at least two storage trays, wherein the insert alters a diameter of the at least two storage trays for limiting movement of a circular saw blade stored therein.

Similarly, neither Groomes nor Leitner teach or suggest the claimed invention. Neither reference teaches or suggests at least two storage trays or an annular insert within the storage

trays wherein the insert alters the diameter of the storage trays for limiting movement of a circular saw blade stored therein. Moreover, Applicant submits that Groomes and Leitner, which are asserted as disclosing a “generally circular” case, are nonanalogous art and should not be combined with Rackley. One skilled in the art of tools and, in particular power tools, who is interested in inventing a case to store and transport saw blades would not look to bingo-carrying cases and certainly would not look to ladies’ makeup cases for ideas. Thus, there is no motivation to combine these references.

Prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. No such suggestion or motivation exists in Rackley, Groomes, or Leitner to provide a generally circular case for carrying and storing circular saw blades including at least two storage trays, an annular insert within the at least two storage trays, wherein the insert alters a diameter of the at least two storage trays for limiting movement of a circular saw blade stored therein as claimed in the present invention. Moreover, there is no expectation of success in the combination of Rackley, Groomes, and Leitner because none of these references teach or suggest all of Applicant’s claim limitations. In particular, none of these references teach or suggest a generally circular case having at least two storage trays and diameter-altering inserts therein. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, Rackley, Groomes, and Leitner, alone or in combination, all fail to teach or describe all of the limitations claimed by Applicant in independent Claim 1 and the claims depending therefrom. Accordingly, Claims 1-5 and 7 are nonobvious under § 103(a).

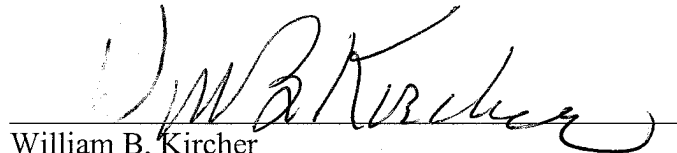
III. Conclusion

Applicant respectfully submits that the claims, as amended, are now in condition for allowance and such is courteously solicited. If any issue regarding the allowability of any of the pending claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's amendment, or if the Examiner should have any questions regarding the present amendment, it is respectfully requested that the Examiner please telephone Applicant's undersigned attorney in this regard. The Examiner's attention is respectfully drawn to the correct attorney docket number shown in the header and on the first page of this response. The Commissioner is hereby authorized to deduct any necessary fees or credit any overpayment of fees in this application to Deposit Account No. 11-0160.

Respectfully submitted,

Date:

11/22/2006



William B. Kircher
Reg. No. 22,481
Blackwell Sanders Peper Martin LLP
4801 Main St., Suite 1000
Kansas City, MO 64112
816-983-8000

ATTORNEYS FOR APPLICANT